



EXPRESS MAIL  
EQ 612963201 US

Examiner:

In response to the Office Action mailed August 30, 2006, please accept the following:

**RESPONSE TO OFFICE ACTION**

**1. Claim 3 Rejection - 35 USC § 103 (a).**

The Examiner cited 35 USC 103(a) as forming the basis for an Obviousness rejection. For the reasons set forth below the Applicant respectfully disagrees with the Examiner. The Examiner rejected Claim 3-5 and 17 pursuant to 35 USC 103(a) as being unpatentable over Ryan in view of Duclos, Jessen and Kobayashi.

The Examiner states that Ryan "discloses a golf club with an alignment line which takes into account downward bowing of a shaft and a golfer's visual parallax error (abstract, Col. 1, Lns. 19-25, 29-35), sweet spot markings, a marking extending from a point at the intersection of the face surface and top surface (Fig. 5), a reference line on a drawing showing non-corrected target lines and corrected lines (Figs. 2, 3, 5), and a bending correction being dependent on the composition of a shaft and speed of the golfer's swing (Col. 3, Lns. 40-50).

The Examiner states that Ryan does not disclose markings on a head for a non-corrected target marking. However the Examiner states that clearly an artisan skilled in assisting a golfer in aligning a club to a ball would have selected a suitable marking arrangement in which having both the non-corrected marking and corrected marking as shown by the reference lines in figures 2-3 and 5 is included.

The Examiner notes that Ryan lacks a grip, balance point target line markings, a line extending from a point at the intersection of the face surface and the top surface, a line across a

top surface ending at a point at the intersection of the top surface with the bottom surface, and a corrected alignment line with (sic which) takes into account only a golfer's visual parallax error.

The Examiner states that Duclos discloses corrected alignment markings to a sweet spot which only take into account a golfer's visual parallax error for a wood type club (Col. 1, Lns. 17-52, Col. 2, Lns. 3-5, Col. 3, Lns. 37-50, Col. 4, Lns. 14-35). The Examiner states that it would have been obvious to modify the club of Ryan to have a corrected alignment marking to a sweet spot which only takes into account a golfer's visual parallax error and not shaft bending in order to provide a club to a player with a swing strength which places very little or no bow on shaft either due to the stiffness of the shaft and/or the weakness of a player and in order to minimize the fitting process of a club to a player by only focusing on the visual error of a club and not the error induced by the bending of a shaft.

The Examiner states that Jessen discloses a golf club having a grip (Fig. 2), an alignment marking (Ref. No. 15, Col. 2, Lns. 20-28) being in the form of a broad line on a top surface (Fig. 6) extending from a point at the intersection of the face surface and the top surface and a line on a head showing non-corrected target line (Fig. 6). The Examiner states that it would be obvious to modify the golf club of Ryan to have a grip in order to minimize the vibrations felt by a player. The Examiner further states that it would have been obvious to modify the golf club of Ryan to have lines on a top surface ending at a back end of a top surface showing a corrected target line in order to utilize a parallax corrected line instead of an arrow marking to assist a player in properly aiming a head who prefers a line while playing a round of golf.

The Examiner states that Kobayashi discloses a head having a top surface intersection in a rear of a head with a bottom surface (Fig. 2) and a center of gravity located behind a sweet spot

such that a head is able to be balanced at the sweet spot (Col. 2, Lns. 44-53) in order to increase distance of flight of a ball with improved directing performance (Col. 2, Lns. 59-62). The Examiner states that it would be obvious to modify the head of Ryan to have a top surface intersect with a bottom surface in order to use the advantages of parallax correction for an alignment of a club for a head which has a bottom surface which intersects with a top surface at a rear end. The Examiner states that such a line on a top surface would end at a point at the intersection of the top surface with the bottom surface. The Examiner also states that it would have been obvious to modify the head of Ryan to have a center of gravity located behind a sweet spot such that the sweet spot is able to be a balance point in order to increase distance of flight of a ball with improved directing performance.

**2. Claims 4-5 and 17 Rejection - 35 USC § 103 (a).**

The Examiner cited 35 USC 103(a) as forming the basis for an Obviousness rejection. For the reasons set forth below the Applicant respectfully disagrees with the Examiner. The Examiner rejected Claim 4-5 and 17 pursuant to 35 USC 103(a) as being unpatentable over Ryan in view of Duclos, Jessen, Kobayashi and Elkins.

The Examiner states that Ryan “discloses a golf club with an alignment line which takes into account downward bowing of a shaft and a golfer’s visual parallax error (abstract, Col. 1, Lns. 19-25, 29-35), sweet spot markings, a marking extending from a point at the intersection of the face surface and top surface (Fig. 5), a reference line on a drawing showing non-corrected target lines and corrected lines (Figs. 2, 3, 5), and a bending correction being dependent on the composition of a shaft and speed of the golfer’s swing (Col. 3, Lns. 40-50).

The Examiner notes that Ryan lacks a grip, balance point target line markings, a line extending from a point at the intersection of the face surface and the top surface, lines on a head showing non-corrected target lines and corrected lines, an increased width line on a top surface ending at a point at the intersection of the top surface with the bottom surface, an (sic and) a corrected alignment line with (sic which) takes into account only a golfer's visual parallax error, and a face line on a top surface (sic at) a predetermined distance from the face..

The Examiner states that Duclos discloses corrected alignment markings to a sweet spot which only take into account a golfer's visual parallax error for a wood type club (Col. 1, Lns. 17-52, Col. 2, Lns. 3-5, Col. 3, Lns. 37-50, Col. 4, Lns. 14-35). The Examiner states that it would have been obvious to modify the club of Ryan to have a corrected alignment marking to a sweet spot which only takes into account a golfer's visual parallax error and not shaft bending in order to provide a club to a player with a swing strength which places very little or no bow on shaft either due to the stiffness of the shaft and/or the weakness of a player and in order to minimize the fitting process of a club to a player by only focusing on the visual error of a club and not the error induced by the bending of a shaft.

The Examiner states that Jessen discloses a golf club having a grip (Fig. 2), an alignment marking (Ref. No. 15, Col. 2, Lns. 20-28) being in the form of a broad line on a top surface (Fig. 6) extending from a point at the intersection of the face surface and the top surface and a line on a head showing non-corrected target line (Fig. 6). The Examiner states that it would be obvious to modify the golf club of Ryan to have a grip in order to minimize the vibrations felt by a player. The Examiner further states that it would have been obvious to have increased width on a top surface ending at a back end of a top surface showing a corrected target line in order to utilize a

parallax corrected line instead of an arrow marking to assist a player in properly aiming a head who prefers a line while playing a round of golf.

The Examiner states that Kobayashi discloses a head having a top surface intersection in a rear of a head with a bottom surface (Fig. 2) and a center of gravity located behind a sweet spot such that a head is able to be balanced at the sweet spot (Col. 2, Lns. 44-53) in order to increase distance of flight of a ball with improved directing performance (Col. 2, Lns. 59-62). The Examiner states that it would be obvious to modify the head of Ryan to have a top surface intersect with a bottom surface in order to use the advantages of parallax correction for an alignment of a club for a head which has a bottom surface which intersects with a top surface at a rear end. The Examiner states that such a line on a top surface would end at a point at the intersection of the top surface with the bottom surface. The Examiner also states that it would have been obvious to modify the head of Ryan to have a center of gravity located behind a sweet spot such that the sweet spot is able to be a balance point in order to increase distance of flight of a ball with improved directing performance.

The Examiner states that Jessen discloses a non-parallax corrected target line (Fig. 6). The Examiner states that Ryan, in view of Jessen, would be obvious to disclose a parallax corrected target line. The Examiner states that Ryan discloses a reference line on a drawing showing non-corrected target lines (Figs. 2,3,5). The Examiner states that Elkins discloses a corrected target line (105) being together with an uncorrected target line (115-116) (Fig. 3) as well as corrected target lines (105b, 115a, 116a) being without any uncorrected target lines (Fig.5). The Examiner states that it would have been obvious to modify (sic the) head of Ryan to have both lines on a head showing a non-corrected target line and a corrected target line in order to assist a teacher in

showing a player or assist a golf manufacturer in showing a potential golf club buyer how severe a ball is misaligned from a sweet spot by not having a parallax correction alignment marking and the need to have a parallax corrected alignment.

The Examiner further states that Elkins discloses a face line (150) in addition to a corrected target line (105) and non-corrected target lines (157-158) on a top surface a predetermined distance from the face (Fig. 6) in order to assist players who customarily used the front face to line up a club who now can use the face line (Col. 7, Lns. 4-22). The Examiner states that it would be obvious to modify head of Ryan to have a face line on a top surface a predetermined distance from the face in order to assist players who customarily used front surface to line up a club.

The Examiner states that he gave very little weight to the method steps of how the parallax corrected target line is made on the head.

### **3. Claim 25.**

The Examiner has failed to comment on Claim 25. Claim 25 was added at the time the Response to the Office Action mailed January 31, 2006 was filed (05 July 2006).

## **DISCUSSION AND RESPONSE**

Applicant intends that this Discussion and Response be applicable to Examiner's rejection of Claim 3 and also Examiner's rejection of Claims 4-5 and 17. Ryan does not have an alignment line. Ryan does not call any of the lines on the drawings target lines. The Examiner appears to agree with the Applicant that Ryan does not disclose or claim lines on the golf club.

The present invention markings are derived from a balance point on the Club Head face surface. Ryan does not mention a balance point.

The present invention claims markings on the clubhead that are derived from a static condition after finding the balance point on the face of the club head component. The location of the balance point is unique and none of the referenced art make use of a balance point. The point of balance is never moved, for any reason, bowing or otherwise, but remains as a constant point of reference. The balance point is determined thru a specific and unique process.

The present invention is unique and different from Ryan and even Ryan combined with Duclos, Jessen, Kobayashi and Elkins.

Without trying to beat a dead horse the inventor repeats his contention that Jessen should not be used as a reference. Jessen is not disclosed or claimed for actual play of golf with a golf ball. Jessen is intended only to be a instruction device. The golf club mentioned in Jessen is described and claimed in combination with a puck as being an instruction device. The golf club is not intended or described as being used without the puck.(ref Col.1 Line 64).

The inventor also respectfully points out that the use of Elkins as a reference is inappropriate as Elkins is concerned with a Putter and not a Wood (driver) or Iron (wedge).

The Examiner has not referenced any art that claims a golf club with markings on the golf club top surface such as claimed by the Applicants invention, in particular the Face Line as disclosed and claimed in Claim 17. Elkins is a putter and not a golf club as the present invention is.

Even if you take Ryan and combine Duclos, Jessen, Kobayashi and Elkins the result is not the golf club with Parallax Corrected Balance Point Target Line or Face Line as disclosed or claimed in the present invention. None of the referenced art place any of their lines in the same location as each other, or specifically as the present invention does. In fact the prior art is silent

as to how the location of the lines are determined, therefore the lines in the prior art are more generic than specific.

As additional arguments that the present invention is not obvious the applicant offers the following:

**1. Unsuggested Modification:** Ryan lacks any suggestion that the reference should be modified in a manner required to meet the claims.

**2. Lack of Implementation:** If the invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. That is—the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

**3. Misunderstood Reference:** The reference does not teach what the examiner relies upon it as supposedly teaching.

**4. Solution of Long-Felt and Unsolved Need:** The invention solves a long-felt, long-existing, but unsolved need. That being to locate the ideal contact point on the face of a clubhead.

**5. Strained Interpretation:** The examiner has made a strained interpretation of the Ryan and Ryan in combination with the other references that could be made only by hindsight.

**6. New Principle of Operation:** The invention utilizes a new principle to locate the ideal contact point. Applicant has blazed a trail, rather than followed one.

**7. No Convincing Reasoning:** The examiner has not presented a convincing line of reasoning as to why the claimed subject matter as a whole, including its differences over the prior art, would have been obvious.



**8. Unsuggested Combination:** The prior-art references do not contain any suggestion (express or implied) that they be combined, or that they be combined in the manner suggested.

**9. References Are Individually Complete:** Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to any reference.

**10. References Take Different Approaches:** The references take mutually exclusive paths and reach different solutions to different problems. Since they teach away from each other, it would not be logical to combine them.

**11. References Teach Away:** The references themselves teach away (expressly or by implication) from the suggested combination.

**12. Impossible to Combine:** Those skilled in the art would find it physically impossible to combine the references in the manner suggested. The markings that the Examiner suggest be added to Ryan would result in a confusing plurality of markings.

**13. Modifications Necessary:** It would be necessary to make modifications, not taught in the prior art, in order to combine the references in the manner suggested.

**14. Claimed Features Lacking:** Even if combined, the references would not meet the claims.

**15. Multiplicity of Steps Required:** The combination suggested requires a series of separate, awkward combinative steps that are too involved to be considered obvious.

**16. Multiplicity of References:** The fact that a large number of references (over three) must be combined to meet the invention is evidence of unobviousness.


No new matter is included.

Reconsideration of your Office Action is requested. No new matter is included. It is

believed that the application is now in proper form for the issuance of a Notice of Allowability and such favorable action is requested. Inventor requests the right to submit Corrections making the drawings formal within the time period set upon issuance of the Notice of Allowability.

Dated: February 28, 2007.

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PATENT:

Atty's Doc. No. UTL 03-032

Title of Invention: GOLF CLUBHEAD MARKINGS, METHODS AND TOOLS

Inventor's Name: BERNARD J. PATSKY

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